REMARKS

Applicant has carefully studied the nonfinal Examiner's Action mailed August 26, 2003 and all references cited therein. The amendment appearing above and these explanatory remarks are believed to be fully responsive to the Action. Accordingly, this important patent application is now believed to be in condition for allowance.

Applicant responds to the outstanding Action by centered headings that correspond to the centered headings employed by the Office, to ensure full response on the merits to each finding of the Office.

Claim Rejections – 35 U.S.C. § 102

Applicant acknowledges the quotation of 35 U.S.C. § 102.

Claims 1, 2, 4, 6, 8 10-12, 14, 16, 18 and 20 stand rejected under 35 U.S.C. 102(b) as being anticipated by Hofmann et al. (U.S. Patent 6,055,453).

In view of the amendment to independent claims 1 and 11, Applicant believes that claims 1, 2, 4, 6, 8, 10-12, 14, 16, 18 and 20 are now in condition for allowance.

By cancellation or amendment of these claims, applicants only wish to advance prosecution of the present application. Applicants reserve the right to prosecute one or more subject matter in the original claims in one or more continuation applications and that equivalence to these claims have not been relinquished by these amendments.

Claim Rejections – 35 U.S.C. § 112

Applicant acknowledges the quotation of 35 U.S.C. § 112.

Claims 37-52 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Office contends that the claims contain subject matter, which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

More specifically, the Office states that independent claims 37 and 45, drawn to a method for facilitating the delivery of a desired molecule into a target tissue comprising administering a continuous low-level electric field to the target tissue for duration of 110ms to 20 minutes fail to comply with the written description requirement. The Office acknowledges that the specification teaches that the method can comprise the application of a single electric field for a duration in the range of 100ms to 20 minutes, but that in order to claim a method comprising the administration of an electric field for 110ms that the specification must have explicit support for this limitation. Applicant respectfully traverses the finding of the Office.

In accordance with MPEP 2163, in asserting a lack of written description restriction under 35 U.S.C. § 112, first paragraph, the examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the original disclosure a description of the invention defined by the claims. Applicant does not believe that this burden has been met by the Office.

To satisfy the written description requirement, the applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed. More specifically, to comply with the written description requirement of 35 U.S.C. § 112, each claim limitation must be expressly, implicitly, or inherently supported in the originally filed disclosure.

Applicant respectfully points out that compliance with 35 U.S.C. § 112 does not require *explicit* (emphasis added) support for each claim limitation. The limitation of 110ms is implicitly and inherently supported by the 100ms to 20 minute range specified in the original filing of the application. Additionally, one skilled in the art would certainly consider the range of 110ms to 20 minutes supported by the original disclosure and within the scope of the invention. As such, Applicant believes that the written description requirement regarding claims 37-52 has been met. The subject matter of independent claims 37 and 45 is clearly supported by the disclosure of the application as filed.

For the reasons cited above, Applicant believes that claims 37-52 comply with the written description requirement and are therefore in condition for allowance.

Claims 21-29 and 31-36 have been allowed.

If the Office is not fully persuaded as to the merits of Applicant's position, or if an Examiner's Amendment would place the pending claims in condition for allowance, a telephone call to the undersigned at (727) 507-8558 is requested.

Very respectfully,

SMITH & HOPEN

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CERTIFICATE OF FACSIMILE TRANSMISSION
(37 C.F.R. 1.8(a))

I HEREBY CERTIFY that this Amendment AF is being transmitted by facsimile to the United States Patent and Trademark Office, Technology Center 1600, Art Unit 1635, Attn: Jon E. Angell, (703) 872-9306 on May 24, 2004.

Dated: March 24, 2004

Shelley Butz

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